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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,536	10/06/2003	Ralph G Fontana	001-235	2535
29569	7590	12/13/2007		
FURR LAW FIRM 2622 DEBOLT ROAD UTICA, OH 43080			EXAMINER MEHTA, NANCY T	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/605,536

**Applicant(s)**

FONTANA, RALPH G

**Examiner**

Nancy Mehta

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (7103579), in view of Geer (5930778), and further in view of Pollin (6041315).

As per claim 1: Philips does not explicitly show

A process comprising the steps of:

having a person write a check to a merchant,

having said merchant forward that check to the merchant's bank.

However, Geer shows a process comprising the steps of: having a person write a check to a merchant, having said merchant forward that check to the merchant's bank (Fig. 1, column 7, lines 4 – 25: where the Item Capture (4) in Fig. 1 performs the function of receipt and comparing of the payment stub with the enclosed check. The enclosed check is written by a person/customer to a merchant for receipt of services or goods from the merchant. The check is then forwarded to the bank (#10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Geer in the method of Phillips, in order

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to provide the user with an option to have the checks submitted either electronically or physically so that the check processing step can be carried out in a more efficient manner.

Phillips shows:

A process comprising the steps of:

having said merchant's bank forwarding said check to a clearing house (Fig. 1, 2),

having said check being returned for insufficient funds (Fig. 2: where at step 222 the reason for check return is clarified, one of the reasons for return of checks being insufficient funds (NSF) or uncollected funds (UCF).),

having said check being returned to said clearinghouse (Fig. 2, step 222 –226: where if a check is returned for NSF or UCF reasons then the check is presented to the ACH at step 226.), and

Phillips does not explicitly show:

having said clearinghouse forwarding said check to a consolidated bank. However, Pollin shows having said clearinghouse forwarding said check to a consolidated bank (Summary, column 4, lines 64 – 67, column 5, lines 1 – 28, column 7, lines 14 – 36: where the collection agency functions as a consolidated bank for collecting payment.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Pollin in the method of Phillips, in order to ensure that the merchant receives his/her payment so that the check need not be written off as bad debt.

As per claim 2: Phillips does not explicitly show:

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A process according to claim 1 that includes the steps of having said consolidated bank collect the funds from said person. However, Pollin shows A process according to claim 1 that includes the steps of having said consolidated bank collect the funds from said person.( Summary, column 4, lines 64 – 67, column 5, lines 1 – 28, column 7, lines 14 – 36: where the collection agency functions as a consolidated bank for collecting payment.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Pollin in the method of Phillips, in order to ensure that the merchant receives his/her payment so that the check need not be written off as bad debt.

As per claim 3: Phillips shows:

A process according to claim 2 that includes the steps said system collect said funds through an electronic recovery (Fig. 1, 2, abstract: since Phillips is an internet based check cashing and clearing method, apparatus and article of manufacture, the funds are transferred electronically.).

As per claim 4: Phillips shows:

A process according to claim 1 that includes the steps of having said system charge said merchant a consolidation fee (Fig. 2, #226 column 4, lines 23 – 25: where the fees can be collected from the merchants account at intervals throughout the month.).

As per claim 5: Phillips does not explicitly show:

A process according to claim 1 that includes the steps of having said merchant endorsing the back of said check specifying said consolidation bank as the return to bank.

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However, Phillips in view of Pollin shows the collection agent collect funds from the payor. It would have been obvious to one of ordinary skill in the art at the time the invention was made to ensure that the merchant endorses the back of the check specifying consolidation bank as the return to bank in the method of Phillips, in order to ensure that returned check is forwarded to the consolidated bank so that it can be processed promptly thereby improving the efficiency of the overall process.

As per claim 6: Phillips shows:

A process according to claim 1 that includes the steps of having said system debit said merchant's account for said returned check (Fig. 2, #226: where the merchant is notified of the returned check in step 224 and the merchant's account is debited in step 226.).

As per claim 7: Phillips shows:

A process according to claim 1 that includes the steps of having said system debit a system account for said returned check (Fig. 2, (#216): where the system debits the consumer's account (system account) after the check information has been submitted to ACH for clearing.).

As per claim 8: Phillips shows:

A process according to claim 1 that includes the steps of having said merchant (Fig. 1, 2).

Phillips does not explicitly show the merchant being a restaurant. However, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention

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from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claim 9: Phillips shows:

A process according to claim 1 that includes the steps of notifying said merchant of said check (Fig. 1, 2).

As per claims 10 and 16: Phillips shows:

A process according to claims 9 and 15, where said notification is done electronically (Fig. 1, 2).

As per claims 11 and 17: Phillips does not explicitly show:

A process according to claims 9 and 15, where said notification is done through the mail. However, notification via mail is an obvious variant of the electronic notification system shown above in Phillips. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Phillips with the ability to make notifications via mail in order to provide the user with an alternate means of notification so that notifications can be sent based on user choice.

Design Choice *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947) "[A design that] is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and ""Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims.""

"

As per claims 12 and 18: Phillips does not explicitly show:

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A process according to claims 9 and 15, where said notification is done through a facsimile. However, notification via facsimile is an obvious variant of the electronic notification system shown above in Phillips. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system in Phillips with the ability to make notifications via facsimile in order to provide the user with an alternate means of notification so that notifications can be sent based on user choice.

Design Choice In re Seid, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947) "[A design that] is a mere matter of choice in ornamentality and produces no new mechanical effect or advantage does not constitute invention and ""Counsel for appellant also present arguments relating to the proportioning and tightness of fit of appellant's devices. Those matters are considered to involve mechanical skill only and to produce no such new or unexpected result as would justify the allowance of the appealed claims.""

As per claims 13 and 19: Phillips shows:

A process according to claims 9 and 15, where said notification is done through the Internet (fig. 1, 2).

As per claim 14: Phillips shows:

A process according to claim 9 where said notification is done through an E-mail (fig. 1, 2).

As per claim 15: Phillips shows:

A process according to claim 1 that includes the steps of notifying said merchant of person who wrote NSF checks (Fig. 1, 2, #228: where the merchant is notified of the return check).

As per claim 20: Phillips does not explicitly show:



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A process according to claim 1, which includes the step of having said system guarantee the payment of, said check. However, Pollin shows a process according to claim 1, which includes the step of having said system guarantee the payment of, said check (column 10, lines 30 – 53: where additional steps can be taken to insulate against non-payment.).

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pollin (20061003) is a system and method for making a payment from a financial account. Cardinal et al. (6757664) is a method and system for verification of checks at a point of sale. Pollin (6041315) is an automated payment system and method. May (4658126) is a check identification system. Menzenski (6123260) is a flagging unverified checks comprising MICR indicia. Funk (5801366) is an automated system and method for point of sale check processing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Mehta whose telephone number is 571-270-3265. The examiner can normally be reached on Monday - Friday 9:00 am - 5:00 pm, alt. Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nancy Mehta



NGA NGUYEN  
PRIMARY EXAMINER

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